IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Steven O Markel	Examiner: Ngoc Vu
Serial No.:	09/997,022	Group Art Unit: 2421
Filed:	November 27, 2001	Docket: 2050.121US1
Title:	Displaying full screen streaming media advertising	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The undersigned requests review of the final rejection in the above-identified Application. No amendments are being filed with this Request, which is filed with a Notice of Appeal for the following reasons.

§112 Rejection of the Claims

Claims 1, 4-7, 9-14, 16-17, 19, 22-25, and 27-29 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Applicant respectfully traverses.

First, the Office states that it "... is unclear to the examiner if the window controls were ever initially enabled" and that "applicant did not point out which features corresponded to each claim." The Applicant respectfully disagrees.

As noted in a prior response, the Application as originally-filed states:

> "The display window employed to present an advertising message may have some or all controls inactivated or disabled. Control buttons, menu options, or mouse indicators may be removed from view, or may be displayed in half-tone to indicate they are in an inactive or disabled state. Further, keystroke combinations or sequences *that control* window display may be disabled." Application, pg. 7, lines 9-12. (emphasis added)

Keystroke combinations or sequences *that control* a window in the present tense are active until they are disabled. Examples of such controls include the controls 102, 104, 106 in Figure 1. Their enabled use is described in the Application at page 5, lines 23-27. After being disabled, such controls can subsequently be re-enabled. In plain English,

something that is "re-enabled" must have been "enabled" at some time in the past; otherwise is makes no sense to use the term "re-enabled" in conjunction with its use.

An example sequence of events is noted in the Application: "[t] the video window is made full size in step 604. Controls for the window are disabled at step 606. ... when the advertising is completed, the video window is returned to its previous size in step 610 and window controls may be re-enabled." Application, pg. 7, lines 18-27. Here the window controls, forming part of a graphical user interface, are disabled, and then re-enabled.

Perhaps the Office confuses disabling and re-enabling window controls that form part of a graphical user interface (e.g., the manipulation of window controls 102, 104, 106 in Figure 1 of the Application) with changes made to the window under program control (e.g., what happens in step 610 of the Application). These are two different activities; the specification clearly describes each of them, including re-enabling disabled window controls that were previously enabled. One of ordinary skill in the art would easily understand the difference between them from the plain text of the Application, as-filed.

Second, as noted in a prior response, the burden is on the Examiner to establish a *prima facie* case to maintain a rejection of non-enablement with respect to the disclosure of a patent application under 35 U.S.C. § 112, first paragraph. No such case has been properly established, because the requisite evidence has not been presented by the Office to support each element of such a case.

Since the specification clearly describes the ability to disable (and re-enable) previously enabled window controls as part of a graphical user interface, and since evidence supporting each of the elements needed to establish a *prima facie* case of non-enablement under § 112, first paragraph, has not been presented, reconsideration and withdrawal of this rejection is respectfully requested.

§*103 Rejection of the Claims*

Claims 7, 9-11 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond (U.S. Patent No. 6,698,020; hereinafter "Zigmond") in view of Kanter (U.S. Patent Application Publication No. 2002/0032608 A1; hereinafter "Kanter"). Claims 1, 4-6, 17, 19, 22,

24, 25 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view of Rashkovskiy (U.S. Patent No. 6,912,504; hereinafter "Rashkovskiy") and further in view of Kanter. Claims 12-14 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Siler (U.S. Patent Application Publication No. 2004/0133467 A1; hereinafter "Siler") in view of Rashkovskiy and further in view of Kanter. However, since a *prima facie* case of obviousness has not been established by the Office in each case, the Applicant respectfully traverses the rejection of these claims.

Independent claims 7 and 23 recite "disabling at least one previously-enabled size control function of [a/said] video presentation window in response to said ad event signal". The Office admits that "Zigmond fails to teach disabling at least one previously-enabled size control function of the display window in response to the ad event signal." The Office goes on to assert that "Kanter discloses that a "user has no control over the ad window such as minimizing the ad in response to a control signal. See 0017." Office Action, Mail Date 20081210, pg. 5.

However, this is not the same as teaching or suggesting the feature of "disabling at least one previously-enabled size control function of [a/said] video presentation window," as claimed by the Applicant in independent claims 7 and 23. As Kanter explicitly states, the "... user has no control over the ad window ...". Kanter, para. [0017]. In other words, the ad window size control described by Kanter was never "previously-enabled" as claimed by the Applicant.

The reply to this argument by the Office in the "Response to Arguments" section of the Final Office Action is somewhat confusing. It reads as follows:

> "As stated, the advertisement window can not easily be closed, minimized, resized, or obscured according to the specification. This does not mean that the advertisement window size control function is "previously enabled" as claimed. In light of the specification, the feature of user has no control over the ad window such as minimizing the ad in response to a control signal in the Kanter reference is relevant to the claimed disabling feature." Office Action, Mail Date 20081210, pg. 2.

It appears that the Office is attempting to read limitations of the Applicant's claims into the teachings of the reference specification, which is improper. Perhaps an alternative explanation by the Applicant would be helpful.

To be "previously enabled" means that the window controls forming part of a graphical user interface were enabled prior to being disabled. Thus, the mere fact that a user has no control over a window size, for example, provides no indication whatsoever as to whether the window controls were "previously enabled" or not. In Kanter, there is no history of window controls ever being enabled (prior to being disabled). That is, the user has no control over the window size from the very beginning. Thus, it is impossible for Kanter to teach the use of advertising window controls that were "previously enabled" as claimed by the Applicant.

Since neither Zigmond nor Kanter disclose this claimed feature, no combination of these references can supply the missing element, and claims 7 and 23 should be in condition for allowance. In addition, any claim depending from a nonobvious independent claim is also nonobvious. *See* M.P.E.P. § 2143.03. Therefore, claims 9-11 should also be in condition for allowance, and the Applicant respectfully requests reconsideration and withdrawal of this rejection of claims 7, 9-11, and 23 under 35 U.S.C. § 103(a).

Similar arguments apply to the rejections by the Office of claims 1, 4-6, 17, 19, 22, 24, 25 and 27-29 – Zigmond in view of Rashkovskiy, and further in view of Kanter; and claims 12-14 and 16 – Siler in view of Rashkovskiy, and further in view of Kanter. In each case, the Office asserts that "Kanter discloses that a "user has no control over the ad window such as minimizing the ad. See 0017." Office Action, pg. 7. This is not the same as teaching or suggesting the feature of "disabling at least one previously-enabled size control function of said display window", (claims 1 and 17) or ""disabling at least one previously-enabled size control function of said video presentation window", (claim 12) or "adjusting said display window to a predetermined size in response to said ad insert event signal, wherein at least one previously-enabled size control function of the display window is disabled," (claim 25) as claimed by the Applicant. This is because Kanter explicitly states that the "... user has no control over the ad window ...". Kanter, para. [0017]. In other words, the ad window size control described by Kanter never was "previously-enabled" as claimed by the Applicant.

Since neither Zigmond, nor Rashkovskiy, nor Siler, nor Kanter disclose this claimed feature, no combination of these references can supply the missing element, and independent claims 1, 12, 17, and 25 should be in condition for allowance. In addition, any claim depending from a nonobvious independent claim is also nonobvious. *See* M.P.E.P. § 2143.03. Therefore,

claims 4-6, 13-14, 16, 19, 22, 24, and 27-29 should also be in condition for allowance, and the Applicant respectfully requests reconsideration and withdrawal of this rejection of claims 1, 4-6, 12-14, 16-17, 19, 22, 24, 25 and 27-29 under 35 U.S.C. § 103(a).

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the undersigned at (210) 308-5677 to discuss any questions which may remain with respect to the Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date MAY 18, 2009 By / Mark V. Muller /
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 18 day of May 2009.

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